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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/767,928 12/17/96 DRYER

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EXAMINER

STARKS, W

ART UNIT

PAPER NUMBER

2762

DATE MAILED:

05/10/00

11

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/767,928**

Applicant(s)  
**DRYER, David et al.**

Examiner  
**Wilbert L. Starks, Jr.**

Group Art Unit  
**2762**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☒ Claim(s) 9 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2762

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicants amendments have been examined.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Regarding Applicant's amendments to overcome the 101 rejection of the first action, Examiner finds that Applicant merely recites the elements of the general computer that Examiner discussed in the first action. While Applicant noted in the Specification that the claimed invention could be realized on an IBM PC compatible computer, the disclosure is not limited to a realization on any *specific* type of computer. Applicant makes it abundantly clear that it is to be implemented on *any* computer. The reasons why such a claim is non-statutory was discussed in the previous two actions. For a more detailed statement on the issue, Applicant is directed to the "35 U.S.C. §101 Computer-Implemented Invention Guidelines", hereafter referred to as "the Guidelines". The Guidelines specifically state that "The mere fact that a hardware element is recited in a claim does not necessarily limit the claim to a specific machine or manufacture." If the claims "define

Art Unit: 2762

the physical characteristics of a computer or computer component exclusively as functions or steps to be performed on or by a computer, and encompass any and every product in the stated class (e.g., computer, computer readable memory) configured in any manner to perform that process”, then the claim must be evaluated with regard to its underlying process. See Guidelines, section IV. B.2. (a)(I). Applicants amendments do not overcome this and the underlying process was shown in the previous actions to be non-statutory as well.

The claims are held by Examiner to be non-statutory as a matter of fact. The rejections in the previous actions stand.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Applicant amends claims 1, 5, and 8 to be drawn to the following claimed points of novelty:

- A. “GUI agents” provided to assist the user in specific tasks.
- B. Statistical multivariate analysis used to schedule agent activities.

Art Unit: 2762

Examiner disagrees. Applicant's attention is drawn to the prior art of the previous action. Suarez illustrates both these features clearly. The "GUI agents" provided to assist the user in specific tasks are anticipated by Suarez, col. 25, lin. 65-67; col. 26, lin. 1-15. The prior art discloses that the agents are controlled by the user as well as the system. User control can be as superficial as determining what services an agent should be allowed to provide, or it can be as detailed as manipulating the internal structure of the agent. All of these are disclosed in Suarez. Applicant's assertions that the agents are somehow isolated from the user interface and do not assist the user make little sense in this context.

Furthermore, Suarez discloses teams of agents, sometimes stationary, sometimes mobile throughout the network, that are available to assist the user. Clearly, Applicant's amendments to claim agents that assist the user are unpersuasive. Examiner finds as a matter of fact that the amendments in claims 1, 5, and 8 with regard to these features do not overcome the prior art.

Regarding the statistical multivariate analysis that is claimed by Applicant to be a point of novelty, Examiner disagrees. Suarez clearly shows this feature on col. 26, lin. 25-31. There, it is shown that the agents maintain statistical information regarding processing time, frequency of requests, frequency of service requests, etc. Examiner finds as a matter of fact that the amendments in claims 1, 5, and 8 with regard to these features do not overcome the prior art.

On these bases, Examiner finds Applicants amendments and arguments to be insufficient to overcome the prior art. The rejections made in the previous actions stand.

Art Unit: 2762

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilbert L. Starks, Jr. whose telephone number is (703) 305-0027. Alternatively, inquiries may be directed to Supervising Patent Examiner Tariq Hafiz whose telephone number is (703) 305-9643.

WLS

May 7, 2000

  
Tariq R. Hafiz  
Supervisory Patent Examiner  
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